

REMARKS

In the Office Action identified above, the Examiner:

- a) rejected claims 1, 4, and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. (U.S. Patent No. 6,784,021, "Abe") in view of He (U.S. Patent No. 6,620,651, "He"), Nam et al. (U.S. Patent Application Publication No. 2002/0109217, "Nam"), and Rogowski (U.S. Patent No. 5,684,707, "Rogowski");
- b) rejected claims 2, 3, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski, and further in view of Sasaki et al. (U.S. Patent No. 6,294,439, "Sasaki");
- c) rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski, and further in view of either Wojewnik et al. (U.S. Patent No. 6,640,434, "Wojewnik") or Varaprasad et al. (U.S. Patent No. 5,910,854 , "Varaprasad");
- d) rejected claim 14 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski, and further in view of Bura et al. (U.S. Patent No. 4,489,487 , "Bura");
- e) rejected claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski, and further in view of Cobbley et al. (U.S. Patent Application Publication No. 2004/0154956A1, "Cobbley"); and

f) rejected claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski, and further in view of Oki et al. (U.S. Patent No. 5,605,844, "Oki").

In the present Amendment, Applicant has amended claims 1 and 6 to more appropriately define the present invention. Claims 1-4 and 6-18 are pending and under current examination.

At the outset, Applicant has amended claim 1 to recite, in part, "first and second semiconductor elements having a thickness of 20 μm or more and 100 μm or less." In addition, Applicant has amended independent claim 6 in a similar manner. Support for the amendments can be found in the specification at, for example, paragraph [0047].

Applicant respectfully traverses the Examiner's rejection of claims 1, 4, and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Abe in view of He, Nam, and Rogowski. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., August 2006 Revision.

A *prima facie* case of obviousness has not been established because, among other things, Abe, He, Nam, and Rogowski, taken alone or in combination, fail to teach or suggest each and every element recited in independent claims 1 and 6.

Applicant has already shown, in the Amendment filed on October 27, 2006, that each of Abe, He, and Nam fails to teach or suggest the claimed “cutting an element adhesive film held by a porous adsorption member,” and “pressing the sectioned element adhesive film held by the porous adsorption member against the first and second semiconductor elements held by the adsorption collet,” as recited in claims 1 and 6. See Amendment filed October 27, 2006, pages 12-14. Indeed, the Examiner states that “Applicant’s arguments, see pages 11-14 of applicant’s response, filed October 27, 2006, with respect to the rejection(s) of claim(s) 1, 4, and 6-8 under Abe et al., in view of He, and Nam et al. have been fully considered and are persuasive.” See the Response to Arguments section of the Office Action at page 7.

The Examiner, however, newly relies on Rogowski, contending that “Rogowski teaches that porous metal plates over vacuum sinks allow for positioning of light weight sheets without deforming the sample into the pore sinks (column 4, lines 51-59).” Office Action at page 4. The cited portion of Rogowski teaches that an apparatus including vacuum sinks 35 covered by a porous metal plate 36, as shown in Fig. 4, is provided to secure the position of thin light weight samples such as paper. The Examiner appears to contend that the porous metal plate 36 of Rogowski corresponds to the claimed porous adsorption member. However, the disclosure of Rogowski does not teach or suggest placing any adhesive film on the porous metal plate 36 nor cutting the adhesive film placed on such a porous metal plate. Therefore, Rogowski fails to teach or suggest the claimed “pressing the sectioned element adhesive film held by the porous adsorption member against the first and second semiconductor elements held by the

adsorption collet,” and “cutting an element adhesive film held by a porous adsorption member,” as recited in claims 1 and 6, and thus fails to overcome the deficiencies of Abe, He, and Nam.

Therefore, Abe, He, Nam, and Rogowski, each taken alone or in combination, fail to teach or suggest the claimed “pressing the sectioned element adhesive film held by the porous adsorption member against the first and second semiconductor elements held by the adsorption collet,” and “cutting an element adhesive film held by a porous adsorption member,” as recited in claim 1 and similarly recited in claim 6.

Moreover, Abe, He, Nam, and Rogowski each fails to teach or suggest the claimed “first and second semiconductor elements having a thickness of 20 μm or more and 100 μm or less,” as recited in claim 1. The cited references are silent regarding semiconductor chips or dies having the claimed thickness range, and thus fail to teach or suggest that the semiconductor elements have a thickness of 20 μm or more and 100 μm or less, as required by claim 1.

Accordingly, no *prima facie* case of obviousness has been established regarding claim 1. Claim 1 is thus allowable over the cited references, and claim 4 is also allowable at least due to its dependence from claim 1. Moreover, claim 6, while of different scope, recites features that are similar to those recited in claim 1. Claim 6 is thus allowable over the cited references, and claims 7-9, which depend from claim 6, are also allowable. The rejection of claims 1, 4, and 6-9 under 35 U.S.C. § 103(a) should therefore be withdrawn.

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 2, 3, 12, and 13 as being unpatentable over Abe in view of He, Nam, Rogowski, and Sasaki; the rejection of claims 10 and 11 as being unpatentable over Abe in view of He, Nam, Rogowski, and either Wojewnik or Varaprasad; the rejection of claim 14 as being unpatentable over Abe in view of He, Nam, Rogowski, and Bura; the rejection of claims 15 and 16 as being unpatentable over Abe in view of He, Nam, Rogowski, and Cobbley; and the rejection of claims 17 and 18 as being unpatentable over Abe in view of He, Nam, Rogowski, and Okj. A *prima facie* case of obviousness has not been established.

Claims 2, 3, and 10-18 depend from claim 1 or claim 6, and thus require each and every element recited in claim 1 or claim 6. A *prima facie* case of obviousness has not been established because, among other things, the cited references, taken alone or in combination, fail to teach or suggest each and every element recited in claims 1 and 6, and required by claims 2, 3, and 10-18.

Applicant has already established above in regard to the rejection of claims 1 and 6 that the combination of Abe, He, Nam, and Rogowski fails to teach at least the claimed “pressing the sectioned element adhesive film held by the porous adsorption member against the first and second semiconductor elements held by the adsorption collet,” and “cutting an element adhesive film held by a porous adsorption member,” as recited in claims 1 and 6. The Examiner relies on each of the additional references for teachings recited in dependent claims 2, 3, and 10-18. However, while Applicant does not accede to the Examiner’s characterization of any of the additional references, Applicant asserts that none of the additional references cited by the Examiner

overcomes the shortcomings of Abe, He, Nam, and Rogowski. Specifically, "pressing the sectioned element adhesive film held by the porous adsorption member against the first and second semiconductor elements held by the adsorption collet," and "cutting an element adhesive film held by a porous adsorption member," as recited in claims 1 and 6, are missing from each of the additional references. Accordingly, no *prima facie* case of obviousness has been established, and the 103(a) rejections of dependent claims 2, 3, and 10-18 should therefore be withdrawn.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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